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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,394	12/18/2001	Kazuhiro Hayashi	Q67780	6473

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/017,394

Applicant(s)

HAYASHI ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to because it appears to be a literal translation of a foreign document, further supported by the references to "kana readings" of Japanese characters in the specification, page 21. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

### ***Claim Objections***

2. Claim 15 is objected to because of the following informalities: Claim 15 has misspelled "server" as "sever" in the preamble. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

6. The term "degree of utilizing the pieces of music in the terminal" in claims 6 and 12 is a relative term which renders the claims indefinite. The term "degree of utilizing the pieces of music in the terminal" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicant has not defined what the term "degree of utilizing the pieces of music in the terminal" means in

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the specification. If Applicant has done so, Applicant is invited to point out to the Examiner where in the specification this information can be found as the Examiner has not located said information within the specification.

7. In regard to claims 1, 7, 13, 15, and 17, the Examiner is unclear of what Applicant means by "one-to-one correspondence". The Examiner has been unable to locate a clear, concise definition of "one-to-one correspondence" within the specification.

8. In regard to claims 1, 7, 13, 15, and 17, the Examiner is unclear of what is meant by content information pieces and by attribute information pieces. Pages 21-22 of the specification give some assistance in stating types of information that can be stored, but the Examiner is unclear how the suggested information possibilities are divided into content information pieces and attribute information pieces. Based upon pages 21-22 of the specification, the Examiner is unable to determine the metes and bounds of content information pieces and attribute information pieces.

9. In regard to claims 1, 13, and 15, the Examiner is unclear on the differences between outputting information and returning information. The claim seems to have intermingled and confused the usage of the two terms so that the Examiner is unclear what Applicant is attempting to separately define between outputting of information and returning of information.

10. In regard to claims 3 and 9, the Examiner is unclear what is meant by storing batch information collectively indicating the whole information stored in the storage section. The Examiner is unsure if the batch information is being stored collectively, if the whole information is collectively indicated, what is meant by whole information, how something is stored collectively on a server, how the batch information is output with the first information and the second information pieces if they are all stored collectively, and what the differences is between the output batch information and the returned batch information.

11. In regard to claims 4-5 and 10-11, the Examiner is unclear if one batch content information item indicates all first information pieces or if individual batch content information items are present for each individual information piece. Likewise, the Examiner is unclear if one batch attribute information item indicates all attributes of all first information pieces or if individual batch attribute information items are present for each individual first information piece.

***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. Claims 15-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15-18 are directed to an *information record medium recording a server or terminal program for a server or terminal computer in a readable form for causing the server or terminal computer to accomplish a task*. It is important to restate and clarify Applicant's claim language. Applicant has claimed a medium for recording a program for a computer in a readable form. Applicant HAS NOT CLAIMED that the form is readable to a computer. This has led the claim to include non-tangible embodiments. A literal reading of the claimed embodiment could encompass a piece of paper (*information record medium*) with a program printed on it (*recording a program for a computer in a readable form*) that tells computer instructions (*for causing the server or terminal computer to...*). Applicant has not defined the metes and bounds of *information record medium* within the disclosure, so this reading is appropriate and within the metes and bounds of the claim language in its broadest possible interpretation. Applicant is reminded that in order for this claim to be deemed statutory subject matter based on a tangible embodiment, Applicant should define the *information record medium* within the specification to limit the reading of *information record medium* to tangible, computer-readable media and amend the claims appropriately to encompass a computer-executable program embodied upon a computer-readable medium.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al. (U.S. Patent No. 5,758,257).

16. In regard to claim 1, Herz discloses *a storage section for storing a plurality of first information pieces; a corresponding information storage section for storing a plurality of second information pieces in one-to-one correspondence with the plurality of the first information pieces, the second information pieces including content information pieces indicating contents of the first information pieces or attribute information pieces indicating attributes of the first information pieces; an output section for outputting the first information pieces to be outputted to a terminal together with the second information pieces corresponding to the first information pieces to be outputted; and a storage control section, wherein when the outputted second information piece is returned from the terminal, the storage control section stores the returned second information pieces in place of the second information pieces before outputting in the corresponding information storage section.* Herz discloses a distribution system for video programming that stores available video programming and matches it to a content profile and a user profile. The content profiles describe the contents of video programs. An "agreement matrix" is kept that regularly updates the correlation of preferences based upon how many customers view the video, user preferences, and other factors. See Herz, column 9, line 60 – column 10, line 53. See Herz, column 4, lines 32-43 and lines 51-58 and column 3, lines 60-67 and column 6, lines 35-66.

17. In regard to claim 2, Herz is applied as in claim 1. Herz further discloses *the second information pieces include the content information pieces and the attribute information pieces.* Herz uses content profiles to describe available programming. See Herz, column 9, line 60 – column 10, line 16.

18. In regard to claim 3, Herz is applied as in claim 2. Herz further discloses *a batch information storage section for storing batch information collectively indicating the whole information stored in the storage section, wherein the output section outputs the batch information together with the first information pieces and the second information pieces to the terminal; and when the output batch information is returned from the terminal, the storage control section stores the returned batch information*

*in the batch information storage section in place of the batch information before outputting.* Herz sends an electronic programming guide to the user as well as the programming. The program guide is updated based on what the viewer watches. Column 22, line 56 – column 23, line 10.

19. In regard to claim 4, Herz is applied as in claim 3. Herz further discloses *the batch information includes batch content information collectively indicating the contents of all first information pieces stored in the storage section or batch attribute information collectively indicating the attributes of all first information pieces.* Herz discloses a programming guide describing what will be shown on a virtual channel. See Herz, column 23, lines 1-10.

20. In regard to claim 5, Herz is applied as in claim 3. Herz further discloses *the batch information includes at least batch content information collectively indicating the contents of all first information pieces stored in the storage section and batch attribute information collectively indicating the attributes of all first information pieces.* Herz discloses a programming guide describing what will be shown on a virtual channel. See Herz, column 23, lines 1-10.

21. In regard to claim 6, Herz is applied as in claim 1. Herz further discloses *the first information pieces are a plurality of music; the content information pieces are titles of the pieces of music, and the attribute information pieces are utilization information pieces indicating degree of utilizing the pieces of music in the terminal.* Herz states that his invention may be utilized for music selection in column 4, lines 34-37. The content and user profiles in column 9, line 60 – column 10, line 53 in a music selection embodiment would be *titles of the pieces of music and degree of utilizing the pieces of music in the terminal.*

22. Claim 7 has substantially the same limitations as claim 1, and the rejection of claim 1 is equally applicable against claim 7.

23. Claim 8 has substantially the same limitations as claim 2, and the rejection of claim 2 is equally applicable against claim 8.

24. Claim 9 has substantially the same limitations as claim 3, and the rejection of claim 3 is equally applicable against claim 9.

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25. Claim 10 has substantially the same limitations as claim 4, and the rejection of claim 4 is equally applicable against claim 10.
26. Claim 11 has substantially the same limitations as claim 5, and the rejection of claim 5 is equally applicable against claim 11.
27. Claim 12 has substantially the same limitations as claim 6, and the rejection of claim 6 is equally applicable against claim 12.
28. Claim 13 has substantially the same limitations as claims 1 and 3, and the rejections of claims 1 and 3 are applied against claim 13.
29. In regard to claim 14, Herz is applied as in claim 13. The additional limitations of claim 14 are substantially the same as the limitations of claim 2, and the rejection of claim 2 is applied against claim 14.
30. Claim 15 has substantially the same limitations as claim 1, and the rejection of claim 1 is equally applicable against claim 15.
31. Claim 16 has substantially the same limitations as claim 2, and the rejection of claim 2 is equally applicable against claim 16.
32. Claim 17 has substantially the same limitations as claim 1, and the rejection of claim 1 is equally applicable against claim 17.
33. Claim 18 has substantially the same limitations as claim 2, and the rejection of claim 2 is equally applicable against claim 18.

#### ***Double Patenting***

34. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

35. Claim 1 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,831,798 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both the instant application and the patent refer to storing a plurality of information including a first partial information and a second partial information and reproducing said partial informations.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

36. Claims 1 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim of copending Application No. 10/015,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because both refer to *a storage section for storing a plurality of first information pieces; a corresponding information storage section for storing a plurality of second information pieces in one-to-one correspondence with the plurality of the first information pieces, the second information pieces indicating attribute information pieces* (defined by claim 6 of the instant application as *a degree of utilizing the pieces of music in the terminal*) which is analogous to *a number of output times the first information pieces has been outputted to a terminal* in the exemplary application, *an output section for outputting the first information pieces to be outputted to a terminal together with the second information pieces corresponding to the first information pieces to be outputted*; and slight variations on returning the *outputted second information piece* from the terminal to the storage.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**Conclusion**

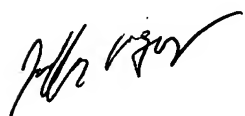
37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hayashi et al.	U.S. Pub. No. 2002/0099706
Katz et al.	U.S. Patent No. 6,560,651
Rapaport et al.	U.S. Patent No. 5,890,152
Kelly	U.S. Patent No. 5,913,204
Nishio et al.	U.S. Patent No. 6,381,651
Yoshida	U.S. Patent No. 6,782,409
Kumagai	U.S. Patent No. 6,449,226
DeMartin et al.	U.S. Patent No. 6,226,672
Tateno	U.S. Patent No. 6,194,647

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER